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09/761,506	01/16/2001	Timothy K. Doherty	BGE-1	5918

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EXAMINER	
GART, MATTHEW S	
ART UNIT	**PAPER NUMBER**
3625	

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/761,506	DOHERTY ET AL.	
	Examiner	Art Unit	
	Matthew s Gart	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 September 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-37 are pending in the instant application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/13/2004 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 24 is rejected under 35 U.S.C. 112 Second Paragraph.

Referring to claim 24. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 24 is dependent from claim 21. Claim 24 discloses a media buyer. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 8-12, 14-21 and 32-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Gever U.S. Patent No. 6,313,835.

Referring to claim 1. Gever discloses an Internet advertising system comprising:

- A multimedia presentation comprising at least one component selected from a group consisting of computer generated animation and full-motion video, a given item within the selected component of the multimedia presentation represented by an embedded placeholder, the embedded placeholder programmed to follow a series of actions of the given item within the multimedia presentation (Gever: column 2, lines 5-36);
- A set of advertisements corresponding to the embedded placeholder, each advertisement being indexed by at least one demographic indicator (Gever: column 1, lines 52-61);
- Means for identifying at least one demographic characteristic of a user (Gever: column 2, lines 37-53);

- Means for selecting one advertisement from the set of advertisements, the selector means including a comparison of the user's at least one demographic characteristic with the at least one demographic indicator of each advertisement to select the most relevant advertisement for the user (Gever: column 2, lines 37-53);
- Means for inserting the selected advertisement into the embedded placeholder of the multimedia presentation, the inserter means creating a seamless advertisement dynamically contained in the multimedia (Gever: column 2, lines 5-36);
- Presentation and targeted to the user's demographic characteristics (Gever: column 2, lines 37-53); and
- Means for delivering the multimedia presentation to the user (Gever: column 15, line 50 to column 16, line 14).

The Examiner notes, even though Gever discloses all of the limitations of claim 1 as indicated supra, the type of element corresponding to the embedded placeholder (i.e. advertisement, slogan, logo, color, text, etc.) constitutes nonfunctional descriptive material. The selecting of the element would be performed the same regardless of the element. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

Referring to claim 2. Gever further discloses a system comprising a hyperlink in the advertisement contained in the multimedia presentation (Gever: Fig. 4, "LINK1, TEXT1").

Referring to claim 3. Gever further discloses a system wherein the hyperlink in the advertisement is a hyperlink to an advertiser's website (Gever: Fig. 4, "LINK1, TEXT1").

Referring to claim 4. Gever further discloses a system wherein the multimedia presentation is an animation (Gever: Fig. 3, "**60**").

Referring to claim 8. Gever further discloses a system wherein the multimedia presentation includes at least two embedded placeholders (Gever: Fig. 4, "PICTURE1, PICTURE2, SOUND1")

Referring to claim 9. Gever further discloses the system comprising multiple sets of advertisements, each set of advertisements corresponding to one of the at least two embedded placeholders (Gever: Fig. 4, "PICTURE1, PICTURE2, SOUND1").

Referring to claim 10. Gever further discloses a system wherein the identifier means includes cookies generated by an Internet browser of the user (Gever: column 15, line 50 to column 16, line 8).

Referring to claim 11. Gever further discloses a system wherein the identifier means includes a survey completed by the user (Gever: column 15, line 50 to column 16, line 8).

Referring to claim 12. Gever further discloses a system wherein the inserter means is a computer program (Gever: Fig. 3).

Referring to claim 14. Gever further discloses a system wherein the computer program is stored on a first server and the multimedia presentation containing the embedded placeholder is also stored on the first server (Gever: column 7, line 56 to column 8, line 2).

Referring to claim 15. Gever further discloses a system wherein the computer program is stored on a first server and the multimedia presentation containing the embedded placeholder is stored on a second server (Gever: column 7, line 56 to column 8, line 2).

Referring to claim 16. Gever further discloses a system wherein the delivery means is an Internet connection between a first server storing the multimedia presentation containing the embedded placeholder and a computer operated by the user (Gever: Fig. 1, "**28**")

Referring to claim 17. Gever further discloses a system comprising a syndication network (Gever: Fig. 1, "**28**").

Referring to claim 18. Gever further discloses a system wherein the syndicated network collects the multimedia presentation and the selected advertisement, and the syndication network delivers the multimedia presentation containing the selected advertisement to the user's computer (Gever: Fig. 1 and Fig. 3).

Referring to claim 19. Gever further discloses a system wherein the syndicated network collects the multimedia presentation and the selected advertisement separate from one another, and a server in the syndication network inserts the selected advertisement into the multimedia presentation (Gever: Fig. 1 and Fig. 3).

Referring to claim 20. Gever further discloses a system wherein the syndicated network collects the multimedia presentation having the selected advertisement inserted therein previous to entering the syndication network (Gever: Fig. 3).

Referring to claim 21. Gever further discloses a system wherein the syndicated network collects information relating to the identifier means from the user's computer and delivers the identifier information to the selector means (Gever: Fig. 5).

Referring to claim 32. Claim 32 is rejected under the same rationale as set forth above in claim 1.

Referring to claim 33. Gever discloses a system according to claim 32 as indicated supra. Gever further discloses a system wherein the selector randomly selects the advertisement (Gever: column 2, lines 37-53).

Referring to claim 34. Gever discloses a system according to claim 32 as indicated supra. Gever further discloses a system wherein the seamless advertisement is dynamically contained in the multimedia presentation (Gever: Fig. 3 and column 2, lines 5-36).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5-7, 13, 22-26 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever U.S. Patent No. 6,313,835.

Referring to claim 5. Gever discloses a system according to claim 4 as indicated supra. Gever further discloses a system wherein the animation is supported by Java. Gever does not expressly discloses a system wherein the animation is created using Flash. Gever does mention that existing tools for preparing Web pages, such as Dreaweaver (A flash component), produced by Macromedia, are relatively complex and a small company, organization or home user does not need such tools and in many cases does not know how to take advantage of their sophisticated features (Gever: column 1, lines 30-40).

To have modified the method of Gever to have included any means of creating animation would have been obvious to the skilled artisan because the inclusion of such means would have been an obvious matter of design choice in light of the system already discloses by Gever. Such modification would not have otherwise affected the system of Gever and would have merely represented one of numerous means that the skilled artisan would have found obvious for the purposes already disclosed by Gever.

Additionally, applicant has not persuasively demonstrated the criticality of providing the flash means versus the means discloses by Gever.

Referring to claim 6. Gever discloses a system according to claim 5 as indicated supra. Gever further discloses a system wherein the animation is an original presentation (Gever: Fig. 2 and Fig. 3).

Referring to claim 7. Gever discloses a system according to claim 5 as indicated supra. Gever further discloses a system wherein the animation is a pre-existing presentation and the embedded placeholder is then added to the pre-existing presentation (Gever: Fig. 2 and Fig. 3).

Referring to claim 13. Gever discloses a system according to claim 1 as indicated supra. Gever does not expressly disclose a system wherein the computer program is Generator (a Macromedia product). Gever does mention that existing tools for preparing Web pages, such as Dreaweaver (A flash component), produced by Macromedia, are relatively complex and a small company, organization or home user does not need such tools and in many cases does not know how to take advantage of their sophisticated features (Gever: column 1, lines 30-40).

To have modified the method of Gever to have included any means of creating and inserting animation would have been obvious to the skilled artisan because the inclusion of such means would have been an obvious matter of design choice in light of the system already discloses by Gever. Such modification would not have otherwise affected the system of Gever and would have merely represented one of numerous means that the skilled artisan would have found obvious for the purposes already

disclosed by Gever. Additionally, applicant has not persuasively demonstrated the criticality of providing Generation versus the means discloses by Gever.

Referring to claim 22. Gever further discloses a system that comprises a buyer providing at least a portion of the set of advertisements (Gever: Fig. 3). Gever does not expressly disclose a media buyer. However these differences are only found in the nonfunctional data stored. Data identifying a particular product set is not functionally related to the system. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store data identifying a plurality of product sets because merely identifying a particular product set for sale would have been obvious. See Gulack cited above.

Referring to claim 23. Gever discloses a system according to claim 22 as indicated supra. Gever further discloses a system wherein the buyer receives information relating to the identifier means from the user's computer (Gever: Fig. 1 and Fig. 5).

Referring to claim 24. Gever discloses a system according to claim 21 as indicated supra. Gever further discloses a system wherein the identifier information from the syndication network is further delivered to a buyer (Gever: Fig. 1 and Fig. 5).

Referring to claim 25. Gever discloses a system according to claim 24 as indicated supra. Gever further discloses a system wherein the identifier information is

delivered from the syndication network to the buyer to the selector means (Gever: Fig. 1 and Fig. 5).

Referring to claim 26. Gever discloses a system according to claim 24 as indicated supra. Gever further discloses a system wherein the identifier information is delivered from the syndication network to the buyer and the identifier information is also delivered from the syndication network to the selector means (Gever: Fig. 1 and Fig. 5).

Referring to claim 37. Claim 37 is rejected under the same rationale as set forth above in claims 1-34.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 27-30, 31 and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever U.S. Patent No. 6,313,835 in view of Gupta U.S. Patent No. 6,487,538.

Referring to claims 27-30. Gever discloses a system according to claim 8 as indicated supra. Gever does not expressly disclose the system comprising:

- An advertisement charge to the sponsor of the selected advertisement delivered in the multi-media presentation wherein the charge is paid to an owner of the multimedia presentation;
- Is apportioned to a group comprising an owner of the multimedia presentation and an owner of a media buyer providing the selected advertisements; or
- Is apportioned to a group comprising an owner of the multimedia presentation, an owner of a media buyer providing the inserted advertisement, and an owner of the delivery means for providing the multimedia presentation to the user.

Gupta discloses the system comprising:

- An advertisement charge to the sponsor of the selected advertisement delivered in the multi-media presentation wherein the charge is paid to an owner of the multimedia presentation (Gupta: column 4, lines 26-37);

- Is apportioned to a group comprising an owner of the multimedia presentation and an owner of a media buyer providing the selected advertisement (Gupta: column 4, lines 26-37); or
- Is apportioned to a group comprising an owner of the multimedia presentation, an owner of a media buyer providing the inserted advertisement, and an owner of the delivery means for providing the multimedia presentation to the user (Gupta: column 4, lines 26-37).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Gever to have included the limitations of Gupta as discussed above so advertisements would be able to appear on web sites that do not normally attract advertisers (Gupta: column 6, lines 10-23).

Referring to claim 31. Gever further discloses the system wherein the delivery means is a syndication network (Gever: Fig. 1 and Fig. 3).

Referring to claims 35-36. Claims 35 and 36 are rejected under the same rationale as set forth above in claims 1-34.

Response to Arguments

Applicant's arguments with respect to claims 1-37 are moot in view of the new grounds for rejection.

Conclusion

Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MSG
Patent Examiner
November 8, 2004